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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,264	03/17/2004	Warren M. Farnworth	MI22-2524	5382

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EXAMINER

KOBERT, RUSSELL MARC

ART UNIT PAPER NUMBER

2829

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/803,264	Applicant(s) FARNWORTH ET AL.	
	Examiner Russell M Kobert	Art Unit 2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1004, 0604 & 0304</u> | 6) <input type="checkbox"/> Other: _____ |

1. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. If lacking lateral terminal ends provides some physical characteristic that is unique, Applicants must indicate and make apparent some physical element or combination of elements that supports this limitation. The specification makes no suggestion to what a "lateral terminal end" is or is not. Moreover, the added limitation, "lacking lateral terminal ends" is so indefinite that no apparatus can be drawn to the claimed limitation because one having ordinary skill in the art does not know how to construct an engagement probe lacking lateral terminal ends.

Moreover, because "lacking lateral terminal ends" is considered a negative limitation, Applicants are reminded that any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984).

In conclusion, since Applicants' added limitation, "lacking lateral terminal ends" is not disclosed in either the specification or drawings, the added limitation is considered

to raise the issue of new matter and in view of the uncertainty of the added limitation, no known apparatus can be drawn to the claimed limitation.

2. Claims 31-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 is indefinite because it is not clear what the claimed invention is limited by. The claim appears to be directed to an engagement probe. The use of such a probe is not considered to further define the physical characteristics of the probe itself. As such the meets and bounds of the invention are limited to the claimed apparatus thus further interpretation of the claimed subject matter is limited only to the physical characteristics of the probe structure by itself. Applicant is reminded that it is a well-known axiom in assessing patentability that a claimed apparatus is characterized by its structure and not its intended use. That is, "apparatus claims must be structurally distinguishable from the prior art." MPEP 2114. In *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In *Hewlett-Packard Co v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: "Apparatus claims cover what a device is, not what it does." (emphasis in original). That is, in an apparatus claim, if a prior art structure discloses all of the structural elements in the claim, as well as their relative juxtaposition, then it reads on

the claim, regardless of whether or not the function for which the prior art structure was intended is the same as that of the claimed invention.

The added limitation in claim 32 of "lacking lateral terminal ends" is indefinite because no configuration of the claimed apparatus can be drawn by consideration of this limitation. Moreover, the claims are indefinite because the specification fails to adequately disclose how and where the claimed engagement probe "lacking lateral terminal ends."

Since the added limitation "lacking lateral terminal ends" is undefined, no additional weight by this limitation has been given claim 32.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 31, 33 and 35-37 rejected under 35 U.S.C. 102(e) as being anticipated by Leedy (5323035).

Leedy anticipates an engagement probe (10) comprising semiconductor bulk substrate material (col 3, ln 49-53), the probe having a grouping of a plurality of projecting apexes (see Figure 4a, insertion structure 60) positioned in sufficient

proximity to one another to collectively removably engage a plurality of different single conductive pads on a plurality of different semiconductor substrates to test circuitry coupled with the single conductive pad (col 6, ln 26-39); as recited in claim 31.

As to claim 33, having the projecting apexes in the shape of multiple knife edge lines (Leedy describes the insertion structure by alternate embodiment wherein the insertion structure has a "blade-like" edge; col 7, ln 55-60) is anticipated by Leedy.

As to claim 35, having outermost portions (20) of a first electrically conductive material is anticipated by Leedy.

As to claim 36, having the projecting apexes projecting from a common plane, wherein the projecting apexes having respective tips and bases, the bases of adjacent projecting apexes being spaced from one another to define a penetration stop plane (region between apexes shown in any of Figures 4a, 5a, 5b, 6 or 7) is anticipated by Leedy.

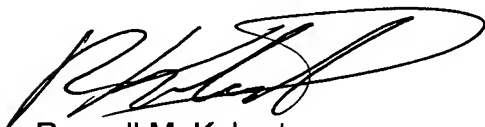
As to claim 37, having the projecting distance being about one-half the thickness of the respective different single conductive pads which the apparatus is adapted to engage (col 3, ln 3-17) is anticipated by Leedy.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wood et al (5585282) shows probe tips formed on a substrate formed of silicon.

6. A shortened statutory period for response to this action is set to expire three month(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (571) 272-1963. The Examiner's Supervisor, Michael J. Tokar, can be reached at (571) 272-1812. For an automated menu of Tech Center 2800 phone numbers call (571) 272-2800.



Russell M. Kobert
Patent Examiner
Group Art Unit 2829
November 22, 2004



DAVID ZARNEKE
PRIMARY EXAMINER

11/22/04